

AMENDMENTS TO THE DRAWINGS

The attached Replacement Sheets of drawings include changes to Figures 3, 4, 5 and 6. The attached Replacement Sheets, replace the original sheets including Figures 3, 4, 5, and 6, and in which Figures 3 (a, b, and c), 4 (a, b, and c), 5 (a, b, c, and d), and 6 (a, b, and c) have been each separately labeled as Figures 3a, 3b, and 3c; Figures 4a, 4b, and 4c; Figure 5a, 5b, 5c, and 5d; and Figure 6a, 6b, and 6c, respectively .

REMARKS

Claims 1, 3 - 13, 18, and 20 are now pending in the application. Claim 9 has been withdrawn from consideration. Claims 2, 14-17 and 19 have been cancelled, without prejudice. New Claim 20 has been added. The Examiner is respectfully requested to reconsider and withdraw the rejection(s) in view of the amendments and remarks contained herein.

ELECTION/RESTRICTION

Applicant acknowledge that the restriction requirement has been made final, and that Claim 9 has been withdrawn from further consideration. Withdrawn Claim 9 is currently being held in abeyance for possible rejoinder (or later prosecution in a related application).

PRIORITY

The Office Action notes that the USPTO has not received a certified copy of the Japanese priority applications and suggests Applicant must provide these certified copies to the USPTO. As noted in the attached copy of the "Notification Concerning Submission Or Transmittal of Priority Document", the International Bureau (WIPO) received copies of the Japanese priority applications within the applicable time limit and in full compliance with PCT Rule 17. Applicant understands that in such cases the certified copies are obtained from WIPO, not from Applicant. See, e.g., the chart at MPEP §1896. Accordingly, Applicant respectfully requests the USPTO obtain the certified copies from WIPO in accordance with MPEP §1896. Applicant further requests notification from the Examiner if the processes outlined in MPEP §1896 do not result in the USPTO obtaining

the certified copies.¹

SPECIFICATION - ABSTRACT

The abstract stands objected to for certain informalities. Applicant has amended the abstract in accordance with MPEP §608.01(b). Therefore, reconsideration and withdrawal of this objection are respectfully requested.

DRAWINGS

The drawings stand objected to for certain informalities. As requested by the Examiner, Applicant has attached Replacement Sheets (3/8, 4/8, and 5/8) for the Examiner's approval. In the Replacement Sheets, Figures 3 (a, b, and c), 4 (a, b, and c), 5 (a, b, c, and d), and 6 (a, b, and c) have been corrected to separately label Figures 3a, 3b, and 3c; Figures 4a, 4b, and 4c; Figure 5a, 5b, 5c, and 5d; and Figure 6a, 6b, and 6c. Accordingly, Applicants respectfully request that this objection be withdrawn.

CLAIM OBJECTIONS

Claims 1, 2, 6, and 8 stand Objected to Because of certain informalities. Claims 1, 6, and 8 have been amended as suggested by the Examiner. (Claim 2 has been cancelled, without prejudice.) Accordingly, Applicant believes these Objections have been overcome, and respectfully request withdrawal thereof.

¹ For example, MPEP §1896 (III), states " If a copy of the foreign priority document is not in the national stage application file but applicant asserts that a certified copy of the priority document was timely furnished under PCT Rule 17 in the international phase, then the examiner should consult with a Special Program Examiner in his or her Technology Center or a PCT Special Program Examiner."

REJECTION UNDER 35 U.S.C. § 102 - '504 REFERENCE

Claims 1, 2, 4, 10, 13-15 and 17 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Japanese reference 2-249504. This rejection is respectfully traversed.

Independent Claim 1 recites, in part: "a second magnet provided directly under the mount surface" and "said mount surface having an erecting action surface for the erecting operation part of said rod-shaped member to perform an erecting action thereon." (Emphasis added.) In contrast, any second magnet of the '504 reference is located adjacent to and above any surface for the content 5 (e.g., brush) to perform an erecting action thereon. In fact, this is true of each and every one of the four embodiments illustrated and described by the '504 reference. Thus, even though the '504 reference discloses a multitude of various different embodiments, all of them locate the second magnet adjacent to and above the erecting action surface. Accordingly, Applicant respectfully asserts that the inventions as recited in Claim 1 (from which the above dependent claims depend) of the present application, are not disclosed or suggested by the '504 reference.

REJECTION UNDER 35 U.S.C. § 103 - '504 REFERENCE WITH TAN

Claims 3, 5, 8, 16 and 18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Japanese reference 2-249504 in view of Tan (U.S. Patent 6,390,434). This rejection is respectfully traversed.

Similar to Claim 1, independent Claim 8 recites, in part: "said second magnet being provided directly under the mount surface" and "said mount surface having an erecting action surface for said rod-shaped member to perform an erecting action thereon." (Emphasis added.) As discussed above, the '504 reference fails to disclose or

suggest a second magnet provided directly under the mount surface” and “said mount surface having an erecting action surface.” Since each of these claims depends from one of independent Claims 1 or 8, they are likewise patentable for at least the reasons discussed above.

In addition, Tan is, first, non-analogous art; and therefore is not properly available to combine with the ‘504 reference to reject the instant claims under 35 U.S.C. §103. The field of the present invention relates to containers including a rod-shaped member, while the field of endeavor of Tan is note paper holders (or paperweights).

Further, the known problems for containers including a rod-shaped member that are addressed by Applicant’s invention, do not correspond to known problems addressed by the note paper holders of Tan. For example, Tan is concerned with (1) keeping the paperweight in a fixed position (i.e., preventing rolling of the paperweight) and (2) minimizing the contact point to reduce friction with the note paper. In contrast, the instant invention is unconcerned with rolling between the components, even reciting a “rolling surface” in the claims. Similarly, the instant invention is unconcerned with minimizing the contact point to reduce friction, even reciting a “flat” (i.e., not minimized) contact surface in the claims.

Although Tan notes that the friction resulting from removing the note paper can cause some “rotation and swinging motion” of the upper part, there is no disclosure or suggestion that any rotation or swinging motion is possible that would move the upper part sufficiently that it would move between a first position adjacent a surface where it cannot be easily grasp, and a second position away from the surface allowing easy grasping thereof. In fact, as noted above, the overall function of Tan is to keep the upper part in a substantially fixed position where it can at all times be easily grasped to insert a note paper. Furthermore, other than the fact that both use magnets, the

structures of containers including a rod-shaped member as claimed and the Tan note paper holders are quite different. In fact, as seen in the drawings of Applicants application, containers including a rod-shaped member are quite often relatively thin in overall structure, while the Tan note paper holder is quite tall and bulky. Accordingly, Applicants respectfully assert that Tan is non-analogous art to that of the claimed, and is therefore not properly combinable with the '504 reference to establish a *prima facie* case of obviousness.

Second, even assuming *arguendo* that Tan is analogous art, one skilled in the art would not be motivated to modify the container of the '504 reference to have the cooperating magnet structure of Tan. The container of the '504 reference is a compact cosmetic container; and as such, is relatively thin overall. It is important to maintain this overall thin structure of this compact cosmetic container. As noted above, the overall structure of the note paper holder of Tan is relatively tall and bulky, and it uses a magnet structure that is likewise tall and bulky. Accordingly, one skilled in the art would not consider the cooperating magnet structure of Tan to be appropriate for use in the relatively thin compact cosmetic container of the '504 reference, absent Applicant's disclosure. The fact that Applicant has been able to develop a relatively thin cosmetic compact container using a flat magnet structure directly under a spherical or ellipsoid magnet structure as recited in Claims 3, 8 and 18 would not have been obvious at the time of Applicant's invention.

Further, Tan does not disclose or suggest "said erecting operation part is provided at one end of a cap, said cap having at the other end thereof an opening that fits to a shape of the one end of said rod part" as recited in Claim 5. In contrast, Tan discloses a magnet that is embedded in an upper part (which appears to have been molded around it). To the extent the bottom part of Tan could be considered a cap-like

structure, there is no disclosure or suggestion to mount such a structure onto the end of a rod part as recited in Claim 5.

REJECTIONS UNDER 35 U.S.C. § 103 - '504 REFERENCE WITH JOULIA OR KUNIK

Claims 6, 7, and 12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Japanese reference 2-249504 in view of Joulia (U.S. Patent 6,286,521). Claims 11 and 19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Japanese reference 2-249504 in view of Kunik et al. (U.S. Patent 3,982,631). These rejections are respectfully traversed.

Each of these claims depends from one of independent Claims 1 or 8. Accordingly, Applicant respectfully asserts they are likewise patentable for at least the reasons discussed above over the '504 reference (alone or in combination with Tan), even if additionally combined with Joulia and/or Kunik et al.

NEW CLAIMS

New Claims 20 - 26 have been added. No new matter is added. Claim 20 is patentable for at least the reasons discussed above regarding Claims 1 and 8. Additionally, none of the prior art references, either singly or in combination, disclose or suggest combining a spherical or ellipsoidal shaped rolling surface and a flat erecting support surface as recited in new Claim 21. Further, none of the prior art references, either singly or in combination, disclose or suggest that the rod-shaped member extend at a non-perpendicular angle to the mound surface, when it is being held in the erect position as recited in new Claim 22. Additionally, none of the prior art references, either singly or in combination, disclose or suggest a pivoting direction of the rod-shaped member when moving into the lying position that is different from the pivoting direction

of the lid when moving into the closed position, much less that these directions are opposite to each other or perpendicular to each other as recited in new Claims 23-25. Lastly, none of the prior art references, either singly or in combination, disclose or suggest locating the mount surface with its erecting action part on the lid and locating the erection restraining part on the base of the container as recited in new Claim 26.

CONCLUSION

It is believed that all of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider and withdraw all presently outstanding rejections. It is believed that a full and complete response has been made to the outstanding Office Action and the present application is in condition for allowance. Thus, prompt and favorable consideration of this amendment is respectfully requested. If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (248) 641-1600.

Respectfully submitted,

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